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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,399	09/22/2005	Minoru Kohara	MIY-0208	2244
74384 7590 03/04/2008 Cheng Law Group, PLLC 1100 17th Street, N.W. Suite 503 Washington, DC 20036				
EXAMINER				
SASTRI, SATYA B				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/04/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/550,399

**Applicant(s)**

KOHARA, MINORU

**Examiner**

SATYA B. SASTRI

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2 and 5-9 is/are rejected.  
7) ☒ Claim(s) 3 and 4 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 9/22/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☒ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 9/22/05  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to application filed on Sept. 22, 2005. Preliminary amendment filed on Sept. 22, 2005 is made of record. Claims 1-9 are now pending in the application.
2. In the IDS filed on Sept. 22, 2005, the foreign document JP-06-075600 is struck off because it is not found pertinent to instant application. Further, the International Search Report cited in the non-patent literature section is not deemed as prior art and is therefore, struck off.
3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on March 27, 2003. Applicants are requested to file a certified copy of the JP 2003-127576 application for official records.

### ***Specification***

4. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use. The "Brief Description of Drawings" typically appears after the "Summary of the Invention".

### ***Arrangement of the Specification***

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without

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underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 6,998,432 B2).

Murakami et al. discloses adhesive compositions comprising an acrylic polymer derived from 40-80 parts by wt. alkyl acrylate such as those having 6-15 carbon atoms in the alkyl group,

10-60 parts of an alkoxy group containing ethylenically unsaturated monomer such as methoxyethyl acrylate, ethoxyethyl acrylate, butoxyethyl acrylate etc. and 1-10% by wt. of carboxy-group-containing ethylenically unsaturated monomer (col. 3, lines 10-20, col. 4, lines 13-20, lines 40-47).

The adhesive compositions further include carboxyl esters such as ethyl myrsitate, isopropyl myristate isopropyl palmitate etc. to promote adhesion to skin (col. 6, lines 6-37).

Furthermore, the acrylic polymers may be crosslinked by chemical means using a variety of chemical crosslinking agents (col. 7, lines 27-45).

The prior art does not disclose the specific copolymers comprising lauryl acrylate, methoxyethyl acrylate and an ionic monomer comprising monomers in the specified range as claimed presently.

The prior art discloses the monomers as claimed presently as suitable monomers. The disclosed ranges also overlap with the presently claimed range. Further given that the genus of the disclosed alkyl (meth)acrylates and alkoxyalkyl acrylate are small, it would be obvious to one of ordinary skill in the art to select lauryl (meth) acrylate, methoxyethyl acrylate and carboxy-functionalized monomers as claimed presently and thereby arrive at the presently cited claims. Further, with regard to the range, the prior art discloses that lauryl (meth)acrylate may be used in amount of 40% by wt. With regard to the amount of methoxyethyl acrylate in the copolymer, it is the examiner's position that the amount may be optimized because it is the compatibilizing monomer for the non-polar alkyl acrylate and carboxy-functional monomer. It would be within the skill of ordinary level in the art to determine the amount of methoxyethyl

acrylate through routine optimization studies so as to achieve optimal compatibility between the comonomers.

7. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al. (US 6,998,432 B2) in view of Imamura et al. (US 5,783,209).

The discussion with regard to the prior art to Murakami et al. in paragraph 6 above is incorporated herein by reference.

The prior art does not include drugs or cosmetic additives in the adhesive compositions.

The secondary reference to Imamura et al. disclose medical pressure sensitive adhesives and medical dressing material. The prior art teaches that the adhesive compositions may include antibacterial substances, hypnotic and sedative drugs, stimulant and antihypnotic drugs and variety of other medicinal additives (col. 5-6, bridging paragraph). It would have been obvious to one of ordinary skill in the art to includes additives with medicinal value in the adhesive compositions of Murakami et al. as taught by Imamura and thereby arrive at the present claims.

***Allowable Subject Matter***

8. Claim 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach or suggest copolymers comprising the presently claimed monomers in the presently claimed ranges.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112. The examiner can be reached on Wednesdays and Fridays, 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Satya B Sastri/

Examiner, Art Unit 1796